

REMARKS

This is responsive to the Office Action of September 13, 2006, in which claims 3, 5, 13, 15, 25, 27, 32-34, 42, and 43 were indicated to be allowable if rewritten in independent form, while the balance of the claims were rejected under 35 USC 102 or 35 USC 103. The Examiner is thanked for the indication of allowability. The prior art rejections are addressed below.

The Examiner has rejected claims 1, 2, 4, 8-12, 14, 18-23, 26, 28, and 36-41 under 35 U.S.C. 102(b) as being anticipated by Laurash (US 5,486,021). It is submitted that this rejection is untenable. In making this rejection, the Examiner has misconstrued the teachings of the Laurash reference.

At the outset of the rejection, the Examiner indicates that "Laurash discloses in Fig. 1, 2 and 4, a label comprising" The Examiner then treats Figs. 1, 2, and 4 of Laurash as though they were illustrating a single structure. In fact, Figs. 1, 2 and 4 of Laurash illustrate three separate and distinct label constructions. None of the three label constructions of Laurash meets the terms of any of the claims of the present application. Claim 1, for example, calls for:

1. (Original) A two-way shipping label construction, comprising:

a strip of release material,

a first printable label having a first surface with a release coating on a portion thereof, and a second surface with a first pressure sensitive adhesive coating, said first printable label adhered to said strip of release material by said first pressure sensitive adhesive coating, and

a second printable label having a first surface, and a second surface with a second pressure sensitive adhesive coating, said second printable label adhered to said strip of release material by said second pressure sensitive

adhesive coating adjacent said first printable label, said second printable label including at least one manifest label defined by a die cut having one or more ties.

The claim calls for two printable labels, with the second of the two printable labels "including at least one manifest label" that is defined by a die cut in the second printable label that has one or more ties. The embodiment of Fig. 2 does not includes two printable labels in accordance with the claim. Therefore, the embodiment of Fig. 2 does not anticipate claim 1. The embodiment of Fig. 2 has a bottom ply 106A, including release material, that is peeled away from the label 102, leaving the tab release portion 124A adhering to the portion of the adhesive 110 under the tab portion 112. The top ply is then adhered to a package by means of the adhesive 110. The card portion 116 and the tab portion 112 are removed at the appropriate stages. The release portion 124A facilitates release of the tab portion 112 since it remains positioned between the adhesive 110 and the package surface. When the card portion 116 is removed, the portion of the package surface is exposed, rather than a portion of the bottom ply 106, as is the case with the three-ply embodiment of Fig. 1. From this, it is clear that the embodiment of Fig. 2 does not have the first and second printable labels called for in claim 1.

Turning to the embodiment of Fig. 1, it is seen that it also does not anticipate claim 1 of the instant application on a number of bases. Claim 1 calls for a "first printable label" that has a "release coating on a portion thereof" which the Examiner indicates corresponds to bottom ply 106 of Laurash. The release coated portion of the claim corresponds to "tab release portion 124" of the first embodiment of the Laurash patent. Claim 1 further specifies that the "second printable label" is "adhered to said strip of release material by said second pressure sensitive adhesive coating" that covers its second surface. As is apparent from Fig. 1, the label 104 is not adhered to the release material 108 by the adhesive 110 which coats its lower surface. The Examiner's suggestion that there is an attachment here which is indirect simply distorts the Laurash disclosure.

Claims 2, 4, and 8-11 depend from claim 1, either directly or indirectly, and are therefore not anticipated by the Laurash patent for the same reasons as stated above. Furthermore, these dependent claims present additional points of distinction. Claim 4 specifies that the "first printable label includes at least one customer receipt label defined by a die cut having one or more ties." The embodiment of Fig. 2 of Laurash does not include first and second printable labels as called for by the claim. The embodiment of Fig. 1, on the other hand, does not include a customer receipt label being die cut from ply 106. The Examiner, in section 1 of the rejection, uses a single run-on sentence to slur together the disclosures of the embodiments of Figs. 1 and 2. The die cut 130 from the release layer 106A in the single printable label embodiment of Fig. 2 does not suggest a die cut around the area 124 in the ply 106 of the dual label embodiment of Fig. 1. In point of fact, the discussion of the manner of use of the two embodiments makes clear why the die cut is needed only in the embodiment of Fig. 2, and not in the embodiment of Fig. 1.

Claim 8 specifies that the "release coating covers substantially all of said first surface of said first label." The embodiment of Fig. 1 of Laurash, on the other hand, does not include a release coating on "substantially all" of the first surface of ply 106. Once again, the Examiner slurs together the disclosures of the two embodiments of the Laurash reference.

Claim 10 specifies that the "first surface of said first printable label includes an area for printing a return address, said area being covered with said release coating such that said return address is obscured from view when said second printable label is secured to said first surface of said first printable label." The embodiment of Fig. 2 of Laurash does not include first and second printable labels as called for by the claim. In the embodiment of Fig. 1 of Laurash, on the other hand, there is no suggestion that the portion 124 is printable. Rather, the suggestion with respect to the ply 106 is that the area beneath the card portion 116 of the ply 106 may carry a duplicate copy of the information printed on the card portion 116. The Examiner states that the "release covers substantially all of the

first surface (see Fig. 2) of the first label (106)" This is, in fact, contradicted by Fig. 2, which shows only portion 124 covered with release material.

Claim 12 calls for:

12. A two-way shipping label construction, comprising:

a strip of release material,
a first printable label having a first surface with a release coating on a portion thereof, and a second surface with a first pressure sensitive adhesive coating, said first printable label adhered to said strip of release material by said first pressure sensitive adhesive coating, said first printable label including at least one customer receipt label defined by a die cut having one or more ties, and

a second printable label having a first surface, and a second surface with a second pressure sensitive adhesive coating, said second printable label adhered to said strip of release material by said second pressure sensitive adhesive coating adjacent said first printable label.

The claim calls for two printable labels. The embodiment of Fig. 2 does not include two printable labels adhered to a strip of release material in accordance with the claim. Therefore, the embodiment of Fig. 2 does not anticipate claim 12.

Turning to the embodiment of Fig. 1, it is seen that it also does not anticipate claim 12 of the instant application on a number of bases. Claim 12 calls for a "first printable label" that has a "release coating on a portion thereof" which the Examiner indicates corresponds to bottom ply 106 of Laurash. The release coated portion of the claim corresponds to "tab release portion 124" of the first embodiment of the Laurash patent. Claim 12 further specifies that the "second printable label" is "adhered to said strip of release material by said second pressure sensitive adhesive coating" As is apparent from Fig. 1, the top ply 104 is not adhered to the release material 108 by the adhesive 110

which coats its lower surface. The Examiner's suggestion that there is an attachment here which is indirect simply distorts the Laurash disclosure.

Claims 14, 20 and 21 depend from claim 12, either directly or indirectly, and are therefore not anticipated by the Laurash patent for the same reasons as stated above. Further, claim 20 calls for the first surface of the first printable label to include an area for printing a return address, "said area being covered with said release coating such that said return address is obscured from view when said second printable label is secured to said first surface of said first printable label." It is clear from Fig. 1 that the upper surface of ply 106 has only release material in portion 124, not in the area of the ply 106 which may carry printed information. It is clear from the disclosure that only the area beneath the card 116 is configured to carry printed information.

Claim 22 is as follows:

22. (Original) A two-way shipping label construction, comprising:

a strip of release material,

a first printable label having a first surface, and a second surface with a first pressure sensitive adhesive coating, said first printable label adhered to said strip of release material by said first pressure sensitive adhesive coating, and

a second printable label having a first surface, and a second surface with a second pressure sensitive adhesive coating, said second printable label adhered to said strip of release material by said second pressure sensitive adhesive coating adjacent said first printable label, said second printable label including at least one manifest label defined by a die cut having one or more ties, said second printable label being smaller than said first printable label.

The claim calls for two printable labels. The embodiment of Fig. 2 of Laurash does not include two printable labels adhered to a strip of release material in accordance with the claim. Therefore, the embodiment of Fig. 2 does not anticipate claim 22.

Turning to the embodiment of Fig. 1 of Laurash, it is seen that it also does not anticipate claim 22 of the instant application on a number of bases. Claim 22 calls for a "first printable label" that is adhered to the strip of release material. The claim further specifies that the "second printable label" is "adhered to said strip of release material by said second pressure sensitive adhesive coating" As is apparent from Fig. 1, the top ply 104 is not adhered to the release material 108 by the adhesive 110 which coats its lower surface. The Examiner's suggestion that there is an attachment here which is indirect simply distorts the Laurash disclosure.

Claims 23 and 26 depend directly or ultimately from claim 22 and are patentable over the Laurash patent for the same reasons as presented with respect to claim 22.

Claim 28 specifies two printable labels on a strip of release material. The embodiment of Fig. 2 of Laurash does not include two printable labels adhered to a strip of release material in accordance with the claim. Therefore, the embodiment of Fig. 2 does not anticipate claim 28. With respect to the embodiment of Fig. 1 of Laurash, it is seen that this embodiment also does not anticipate claim 28. Claim 28 specifies that both the first and second printable labels are adhered to the strip of release material. It is clear that the embodiment of Fig. 1 is not so arranged.

Claim 36 calls for first and second printable labels on a strip of release material. The embodiment of Fig. 2 of Laurash does not include two printable labels adhered to a strip of release material in accordance with the claim. Therefore, the embodiment of Fig. 2 does not anticipate claim 36. With respect to the embodiment of Fig. 1 of Laurash, it is seen that this embodiment also does not anticipate claim 36. Claim 36 specifies that both

the first and second printable labels are adhered to the strip of release material. It is clear that the embodiment of Fig. 1 is not so arranged. Claim 37 and 38 depend from claim 36 and are patentable over the Laurash patent for the same reasons presented above in regard to claim 36.

Claim 39 calls for first and second printable labels on a strip of release material. The embodiment of Fig. 2 of Laurash does not include two printable labels adhered to a strip of release material in accordance with the claim. Therefore, the embodiment of Fig. 2 does not anticipate claim 39. With respect to the embodiment of Fig. 1 of Laurash, it is seen that this embodiment also does not anticipate claim 39. Claim 39 specifies that both the first and second printable labels are adhered to the strip of release material, and it is clear that the embodiment of Fig. 1 is not so arranged. Claim 40 and 41 depend from claim 39 and are patentable over the Laurash patent for the same reasons presented above in regard to claim 39.

Claims 24 and 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Laurash in view of Bulka (US 5,343,647). It is submitted that this rejection is untenable. In making this rejection, the Examiner has again misconstrued the teachings of the Laurash reference. The Laurash patent is deficient with respect to claims 24 and 31 for the same reasons as given above with respect to claims 22 and 29, from which they respectively depend. The citation of the Bulka reference does nothing to correct this deficiency. Further, these claims specify using a repositionable pressure sensitive adhesive coating on said second printable label. The Examiner takes the position that it would be obvious to substitute repositionable adhesive for permanent pressure sensitive adhesive "for providing a label substrate which can be removed and adhered onto another item." This rejection is predicated on a hindsight assessment of the references. A person of ordinary skill, looking at the Laurash reference would not find that it should be modified with a repositionable adhesive, since it is capable of functioning in the desired manner without modification.

Claims 6, 7, 16, 17, 29, 30 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Laurash. The Laurash reference is deficient in its teachings, as pointed out above with respect to these claims for the same reasons as pointed out above with respect to the independent claims from which these claims depend.

It is submitted that all of the claims pending in the instant application are patentable. Early notice of favorable action is respectfully requested.

CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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